70-253

Supreme Court, U.S.
FILED
JUL 2 1971
E. ROBERT SEAVER, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1970

[redacted]

DEERE & COMPANY,
Petitioner,

vs.

HESSTON CORPORATION, HESSTON OF TEXAS, INCORPORATED, and JOE ED CRAWFORD, d/b/a CRAWFORD EQUIPMENT COMPANY,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

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No. 1797

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BRIEF FOR RESPONDENTS IN OPPOSITION

STATEMENT OF THE CASE

Background

The four patent claims (15, 16, 18, 19) held invalid below relate to the air separation of ripe cotton from green bolls through use of a blower arranged to present a so-called "jet pump". The Patent Office considered a prior

art patent cited by petitioner (Harazin, DX 29; Finding 6, App. D of Petition, p. 12a) and disclosing the jet pump principle for *conveying* cotton, but failed to locate prior art using the principle for *separation*.

The claims were allowed on the additional argument that the prior art considered by the Patent Office also failed to show a certain air regulating principle which petitioner represented to the Examiner as being *an important feature* of the claims (Findings 8 and 9, App. D of Petition, pp. 12a, 13a).

However, by a simple patent search, respondents located a German patent (Gerson, DX 38, 39) *also* anticipatory of the jet pump principle which, as distinguished from Harazin, is used in the *separation* of light and heavy materials, as in the claims; and a Herz patent (DX 28) disclosing the air regulating principle (*the important feature*) used with a suction pump for air separation of light and heavy materials (Findings 15, 16, App. D of Petition, pp. 14a, 15a).

Therefore, the two arguments to the Patent Office lost their significance, leaving petitioner with the problem of attempting to develop *new* arguments in an effort to defend the validity of the claims. The sole question before the lower courts then became that of determining the obviousness of the subject matter of the claims in view of the prior art relied upon by the respondents.

Allowance of Patent Claims on the Basis of a Hole with an Adjustable Door

Judge Bell correctly noted "the prime essential in Deere's patent: a regulating means for affecting the intensity of the secondary stream in connection with the separation chamber" (App. A of Petition, p. 5a). This affirmed Findings 8 and 9 of the trial court (App. D of Pe-

tition, pp. 12a, 13a) making significant the initial argument that such single feature, not shown in the prior art cited by the Patent Office, was important to the allowance of the patent claims in issue (DX 25, p. 45).

It consists of nothing more than an *opening* "in the form of a window on the vertical duct and above the separation chamber" (App. A of Petition, p. 2a). In simple operation, air "is regulated by the degree to which the window is opened" (App. A of Petition, pp. 2a, 3a). As conceded by petitioner, the "adjustable air-inlet means (admittedly old, *per se*)" (Petition, p. 16) is a mere "bleed-in door" (Petition, p. 7).

Claims Relate Only to the Use of the Old Air Bleed-In Door with an Old Basic Structure

The claims invalidated by the lower courts describe in detail that which petitioner concedes to be a conventional "jet pump as a source of suction (also admittedly old, *per se*)" (Petition, p. 16). Judge Bell recognized that Harazin (DX 29) "teaches the use of a jet pump in an air elevator to convey cotton" (App. A of Petition, p. 4a) and that Gerson (the German patent) (DX 38, 39) "employed the jet pump principle for use in the separation chamber and to elevate the lighter materials through a duct to a collection point" (App. A of Petition, p. 5a). This affirms Findings 11, 12 and 16 of the trial court (App. D of Petition, pp. 13a-15a) as to lack of novelty in the basic structure specified in the claims.

Moreover, petitioner admits that Harazin employed a jet pump "for the purpose of transporting cotton fiber to the collection point" (Petition, p. 11), and that Gerson, not cited by the Patent Office, "discloses the use of a jet pump (k) for separating" heavy and light materials, with the light components "carried upward" and delivered to a "collection area (h)" (Petition, pp. 11, 12).

Prior Material Separation Art Not Cited by the Patent Office Discloses Doors Used to Bleed in Air for the Same Purpose As the Claims

Judge Bell noted that Herz (DX 28) "teaches the use of windows between the separation chamber and the vertical duct as air regulating means to maintain the velocity of the air stream above the windows while reducing the velocity below the windows" (App. A of Petition, p. 5a). To the same effect is Finding 15 of the trial court (App. D of Petition, pp. 14a, 15a). Petitioner admits the provision in the air separator of Herz of "a pair of openings (18) near the top of the zone in which separation" occurs, that are "provided with adjustable flaps (19)" (Petition, pp. 13, 14).

Thus, in conceding that both the "adjustable air-inlet means" and the "jet pump as a source of suction" are "admittedly old, *per se*" (Petition, p. 16), petitioner is in full agreement with the joint findings of the lower courts that "the jet principle was old in a similar field of endeavor as was the air regulating means", and that "the jet principle and the air regulating means principle are in the public domain" (App. A of Petition, p. 6a).

The Decision Below Turned on Its Own Facts

The sole question left for decision below was whether or not it would have been obvious to one skilled in the art of air separation of materials to substitute in the air separator of Herz another old type of unmodified air motivating structure (as taught by Harazin and Gerson), without changing the air regulating means of Herz in any way.

From the foregoing statement of pertinent facts, not contested by petitioner, and the argument to follow, it will be readily apparent that this relatively simple case is not one which is worthy of or requires review by this Court.

The petition fails to present any meritorious reason justifying reconsideration of the uniformity of thought by the two courts below in their application of the obviousness test to the particular facts of this case.

REASONS FOR DENYING WRIT

Contrary to petitioner's contentions as presented (Petition, pp. 2, 3), the standard of patentability applied *in this case* is fully warranted by the law (35 U.S.C. 103) relating to obviousness, and is wholly consistent with the decisions of this Court; and there is no conflict, irreconcilable or otherwise, among the decisions of the various panels of the Court of Appeals for the Fifth Circuit. While the only relevant question properly presented herein is whether or not the correct test was applied by the panel sitting *in this case,* not the correctness of tests applied by other panels in previous cases, we shall, nonetheless, show that the alleged conflict does not in fact exist.

Petitioner Itself Is Urging a Test Which Is Inconsistent with the Decisions of This Court

In *Graham* v. *John Deere Co.*, (1966), 383 U.S. 1, 4, 15 L.Ed. 2d 545, 549, 86 S.Ct. 684, the Fifth Circuit predicated patent validity on the proposition that the combination produced an "old result in a cheaper and otherwise more advantageous way". The Eighth Circuit held the same patent invalid because "there was no new result in the patented combination". This Court "determined that neither circuit applied the correct test" and concluded "that the patent is invalid under § 103 * * *".

Yet, in face of that test as required by this Court, petitioner repeatedly speaks of an alleged "new result" (e.g., Petition, pp. 8, 16, 17) in its patented combination. On that note, petitioner then cites several Fifth Circuit de-

cisions in support of the mistaken contention that therein a test differing from that applied in this case was correctly used (Petition, pp. 24-26). But in each such instance, it was found that *more* was contributed by the respective inventors than a mere new, cheaper or more advantageous result.

In *Gray Company* v. *Spee-Flo Manufacturing Corporation*, 5 Cir. 1966, 361 F.2d 489, 491, as pointed out by petitioner (Petition, p. 24), the contribution was the determination of a proper size relationship between two orifices to accomplish an improved spray pattern.

In referring to *Sterner Lighting, Inc.* v. *Allied Electrical Supply, Inc.*, 5 Cir. 1970, 431 F.2d 539 (Petition, pp. 25, 26), petitioner fails to call to attention the fact that the patent there in suit was held valid on the ground that it was "not broad and general" but provided "a highly specific solution to a particular set of problems * * *" (431 F.2d 539, 542).

In *Metal Arts Company* v. *Fuller Company*, 5 Cir. 1968, 389 F.2d 319, petitioner again points out (Petition, p. 25) that the patent therein was not held valid without basis. The prior art reference "was aimed at a result opposite to that of" the patent in suit; "was aimed at a wholly different problem, performed a different function, and could not have been used without modification, to accomplish the ends sought by" the patent in question (389 F.2d 319, 323).

Hensley Equipment Co. v. *Esso Corp.*, 5 Cir. 1967, 383 F.2d 252, did not involve a mere combination of elements, all previously known, as in the instant case. In *Smith Industries International* v. *Hughes Tool Co.*, 5 Cir. 1968, 396 F.2d 735, the prior art simply did not teach the invention of the patent therein held valid. The novel combination of the patent claim in question in *Williams Bit & Tool*

Co. v. *Christensen Diamond Products Co.*, 5 Cir. 1968, 399 F.2d 628, solved, to a substantial degree, many problems concerning which obvious solutions had not previously been suggested.

In the instant case, however, Judge Bell found no contribution other than the fact that "the combination of these known elements produced a useful function" (App. A of Petition, p. 6a); and, as will hereinafter be made clear, contrary to petitioner's contentions, the combination did not even produce a "new" result.

In Adopting Two Old Public Domain Principles, Petitioner Made No Change Whatsoever in the Prior Art Structures

Petitioner correctly admits that "the device covered by the claims of the patent in suit in this case can be produced by combining the jet pump shown in the Harazin prior art patent and the air regulating means employed in the Herz patent" (Petition, p. 21). It not only "can" be done, but "was" done, and entirely *without modification*, as was demonstrated at the trial (Joint Appendix, p. 351).

Respondents exhibited to the trial court, as shown by Illustration I hereof, a connection of the riser 3 of Herz between flaps 19 and hopper 4 (Fig. 1, DX 28) with the shaft "a" of Gerson between channel "c" (DX 38) and opening "f". This perfect match, when compared with Fig. 5 (Illustration II) of petitioner's patent, or for that matter, Fig. 3 also (Illustration III), vividly demonstrated, *as a fact*, that petitioner did no more than add the air adjusting means of Herz to the jet pump of Gerson. (Fig. 5 shows baffle 84 hinged at its upper edge as are the flaps 19 in Fig. 4 of Herz.)

Respondents also showed the trial court (Joint Appendix, p. 354), as seen by Illustration IV, the same con-

nection of the Herz riser 3 to the conduit 3 of Harazin above the trough 1 (Fig. 2, Illustration III). Here again, respondents established, *as a fact,* that by merely bringing the diameters of riser 3 and conduit 3 into conformity, petitioner simply added the air adjusting means of Herz to the jet pump of Harazin.

The result is self-evident (Joint Appendix, pp. 277, 278). Each structure of Illustrations I and IV has a jet pump, precisely as defined by the claims in issue (Findings 11 and 12, App. D of Petition, pp. 13a, 13b), provided with "air regulating means on the separating chamber", with "the intensity of the secondary stream in relation to the mixture" effected in each such structure, as claimed (Finding 9, App. D of Petition, p. 13a).

Petitioner emphasizes a so-called "compromise" problem (Petition, pp. 6, 7).* But Herz carefully explains how to solve the problem by creating enough air to lift the light materials to the collecting point while at the same time adjusting the air velocity in the separating chamber such as to not lift foreign matter (DX 28, p. 2, lines 70-95). What petitioner chooses to ignore is the fact that in Illustrations I and IV there is no suction fan; instead, prior art jet pumps are shown. Obviously petitioner has not contended that there would still be a "compromise" problem when Herz's air regulating means is used with the jet pumps of Harazin or Gerson. That would be tantamount to saying that the problem still exists in the apparatus of petitioner's patent.

*Significantly, the discussions in the petition as to the alleged attributes of the combination of the claims and the reasons given in support of nonobviousness contentions are, for the most part, afterthoughts not embodied in the patent itself or in the arguments to the Patent Office.

Combining Two Old Principles Without Change Produced No Wholly Unexpected Operating Characteristics

There is no merit to petitioner's contention that this case comes under the decision of this Court in *United States* v. *Adams*, 1966, 383 U.S. 39, 15 L.Ed. 2d 572, 85 S.Ct. 708. Petitioner's jet pump *per se* is virtually identical with the jet pump of Harazin (Illustration III, Fig. 2). It is also the same jet pump as disclosed by Gerson (Illustration II, right hand view). As was obvious to Judge Bell, both references are in "a similar field of endeavor" (App. A of Petition, p. 6a). Harazin "teaches the use of a jet pump in an air elevator to convey cotton" (App. A of Petition, p. 4a). Gerson "teaches the use of the jet pump to separate and elevate" (App. A of Petition, p. 5a). "This leaves the air regulating means * * *" (App. A of Petition, p. 5a).

Herz teaches the air regulating means (App. A of Petition, p. 5a). Illustration I shows the air regulating means of Herz coupled with the jet pump of Gerson. Illustration IV shows the air regulating means of Herz coupled with the jet pump of Harazin. No alteration whatever is made in Illustration I to the jet pump of Gerson, in Illustration IV to the jet pump of Harazin, or in Illustrations I and IV to the air regulating means of Herz.

It is impossible, therefore, to find the wholly unexpected, valuable operating advantages or characteristics in such combination of old principles found at 383 U.S. 39, 51, 15 L.Ed. 572, 580 in the patented battery of *United States* v. *Adams*.

Finding the Combination Reasonably Obvious to One Skilled in the Air Separation Art Meets the Requirements of This Court

This petition exemplifies the faint hope that if this Court will once again review the factual evidence before the two lower courts and retry the case a different conclusion will somehow be reached. Petitioner noted the failure to argue "synergistic result" in *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 1969, 396 U.S. 57, 61, 24 L.Ed. 2d 258, 261, 90 S.Ct. 305, and on that clue, argued the matter at length (Petition, pp. 2, 3, 14, 23, 24, 26, 27). Although the use of the term "synergistic" by this Court was not at all necessary to the decision therein and cannot be regarded as controlling in all patent cases regardless of the facts, petitioner is assuming that if, in a combination of old elements situation, the synergism test is raised, the obvious-nonobvious test will be foreshadowed.

The argument carries no weight in this case, however, because of the facts. Here we have in the prior art two types of devices for producing currents of air to separate materials. Gerson does it with a blower arranged as a jet pump. Herz uses a suction blower. In the apparatus of petitioner's patent the bleed door used with the suction blower of Herz is now shown by petitioner with the blower of Gerson or Harazin.

The jet pump shown in petitioner's patent creates a flow of primary and secondary air in the same way as does the jet pumps of Gerson and Harazin. The secondary air raises the light materials out of the mixture precisely as does the jet pump of Gerson. The heavy materials gravitate out of the mixture and the light materials become entrained in the primary air after separation so as to be blown thereby to a point remote from the separation chamber exactly as in the case of the jet pump of Gerson.

And the adjustment of the bleed-in door lets in more or less air above the separation chamber the same as the bleed-in flaps of Herz. Thus, each of the elements of the claims performs its same respective function in petitioner's combination as it did in the prior art.

It matters not an iota whether the use of a simple, ordinary bleed door helps to produce a new, better or different result when used with the blower of an old jet pump as compared with the results of its use with a commonplace suction blower. Anyone skilled in the art of air separation would readily recognize the obviousness of the same association of the air bleed-in door of Herz with a different type of conventional blower.

Legal Inferences and Subtests Fail to Tip Scales of Patentability

Judge Bell duly considered the fact that infringement was not contested (App. A of Petition, pp. 1a, 3a, 6a); the problem that faced the industry (App. A of Petition, p. 2a); and successful test results followed by commercial success (App. A of Petition, p. 3a), all as sanctioned by this Court in *Graham* v. *John Deere Co.*, 1966, 383 U.S. 1, 35, 36, 15 L.Ed. 2d 545, 566, 567, 86 S.Ct. 684. Petitioner's reliance again on those secondary factors (Petition, pp. 2, 5-10, 19) cannot overcome the fact that the prior art, which could have been located by a simple search, disclosed the solution and demonstrated the obviousness of the subject matter of the claims.

Standard of Patentability Herein Applied Conforms Fully with the Admonitions of This Court

Petitioner complains because the courts below refused to lower the requirements, stating that the standard as applied was unwarranted, inconsistent with the decisions of this Court and in conflict with other panels (Petition,

pp. 2, 3); makes it impossible to meet by other combinations of old elements (Petition, p. 20); is much too "stringent" (Petition, p. 23); and precludes advice of counsel (Petition, p. 26).

The fact remains that this Court continues to require "strict observance" of the obviousness test as set forth in *Graham* v. *Deere* at 383 U.S. 1, 18, 15 L.Ed. 2d 545, 556. See *Anderson's-Black Rock* v. *Pavement Salvage Co.*, 1969, 396 U.S. 57, 62, 24 L.Ed. 2d 258, 262.

Moreover, *Graham* v. *Deere*, 1966, 383 U.S. 1, 19, 15 L.Ed. 2d 545, 547, stated that "it bears repeating that we find no change in the general strictness with which the overall test is to be applied". It is a "rather severe test" when a "conjunction", "concert" or "unification" of "known elements" is involved. *Great A & P Tea Co.* v. *Supermarket Equip. Corp.*, 1950, 340 U.S. 147, 152, 95 L.Ed. 162, 166, 167.

As stated by Judge Bell in *Sisko* v. *Southern Resin Fiberglass Corp.*, 5 Cir. 1967, 373 F.2d 866, 868, he followed the decision of *Graham* v. *Deere* in *Up-Right, Inc.* v. *Safway Products, Inc.*, 5 Cir. 1966, 364 F.2d 580, and in the latter case, the conclusions were based on the same test (p. 869), as was also the basis for invalidity in *Zero Mfg. Co.* v. *Mississippi Milk Pro. Ass'n*, 5 Cir. 1966, 358 F.2d 853, 859.

Petitioner has failed to show that the Fifth Circuit should be admonished for applying the required "severe test" when justified by facts such as were fully and clearly developed by the record herein.

The decision in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.*, ... U.S. ....., 28 L.Ed. 2d 788, 91 S.Ct. ....., decided May 3, 1971, relating to *res judicata* and collateral estoppel as affirmative

defenses, presents no legal basis for writ of certiorari herein as suggested by petitioner (Petition, p. 27).

CONCLUSION

For the foregoing reasons this petition for writ of certiorari should be denied.

Respectfully submitted,

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ILLUSTRATION I

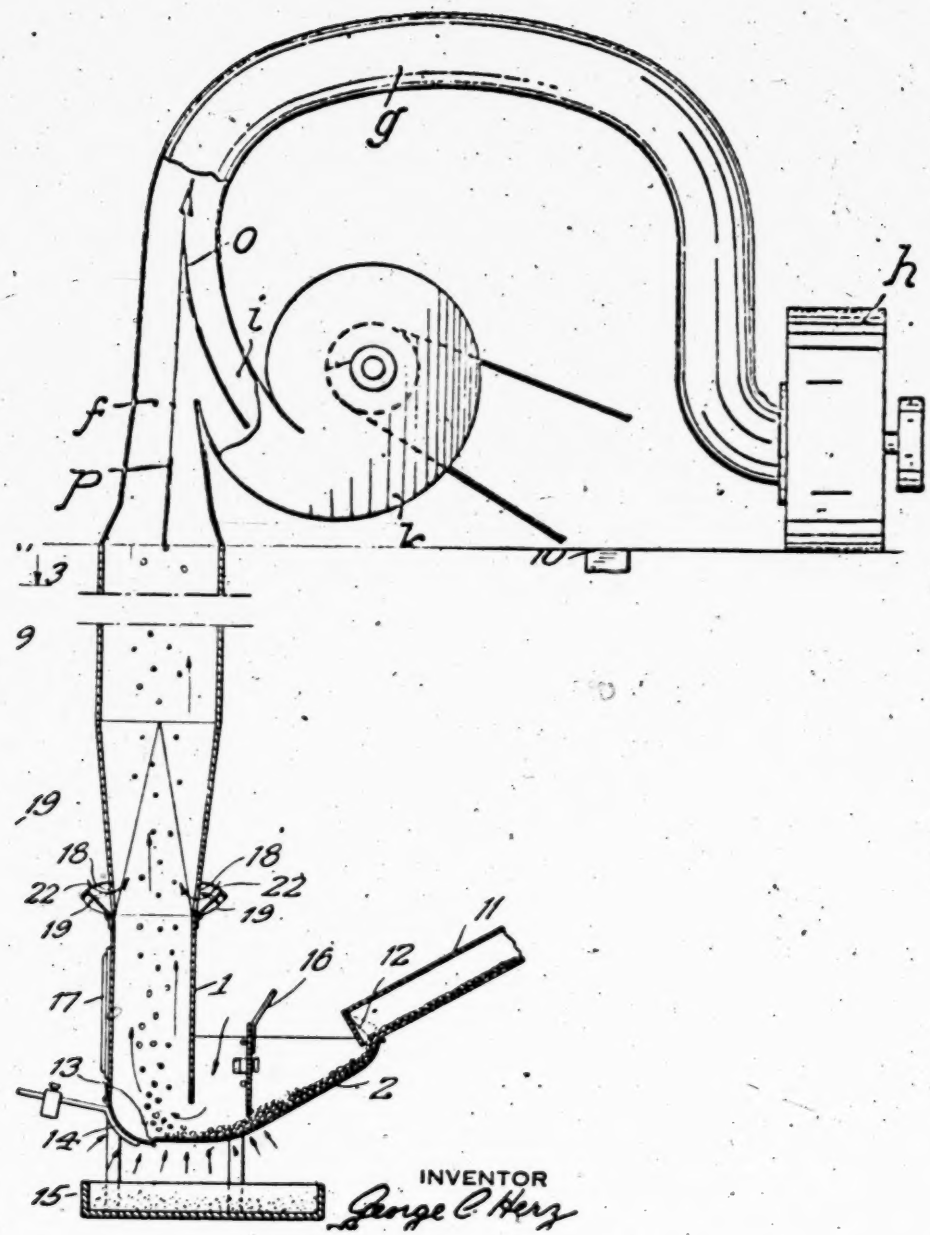


ILLUSTRATION II

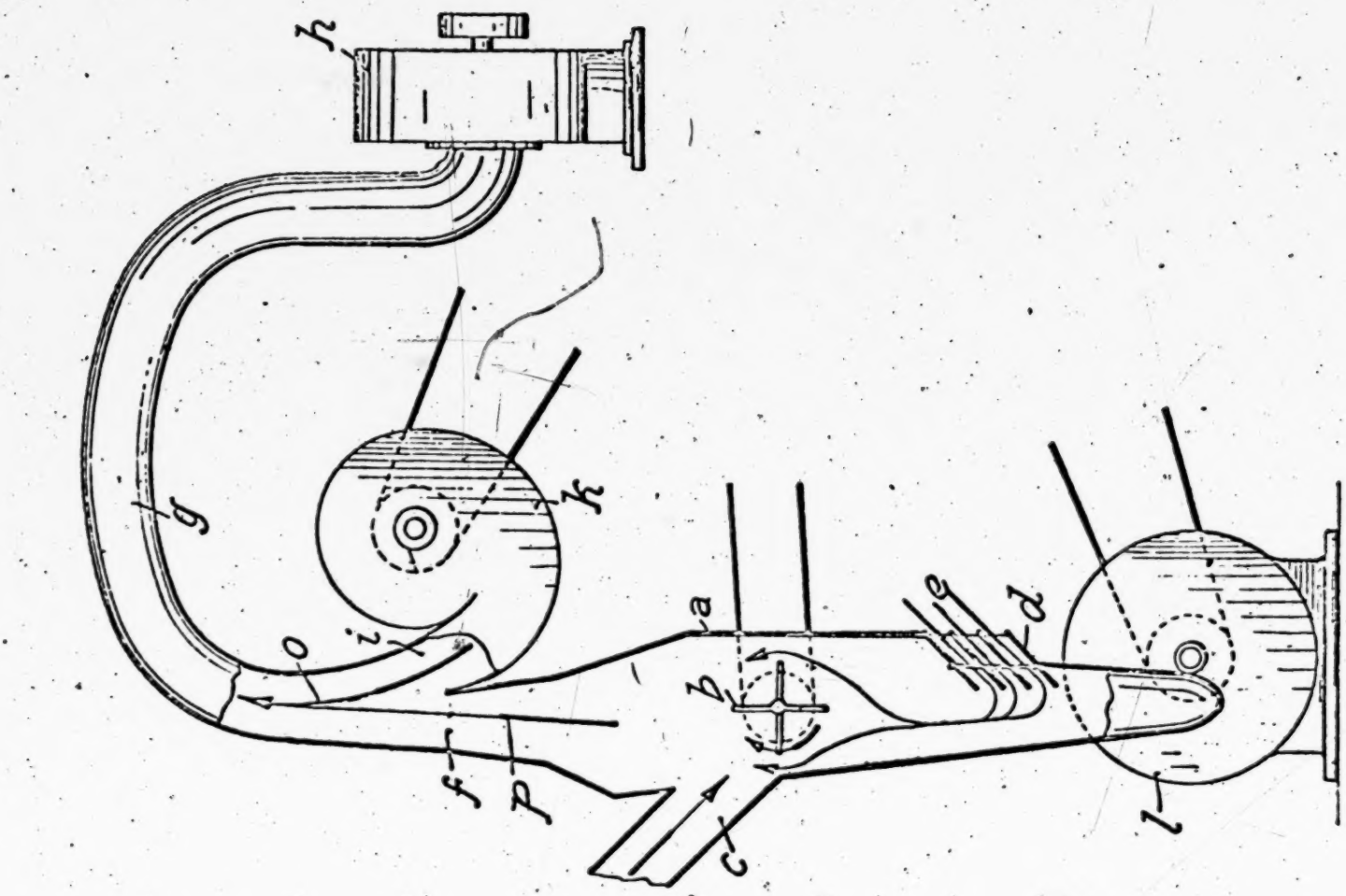


FIG. 5

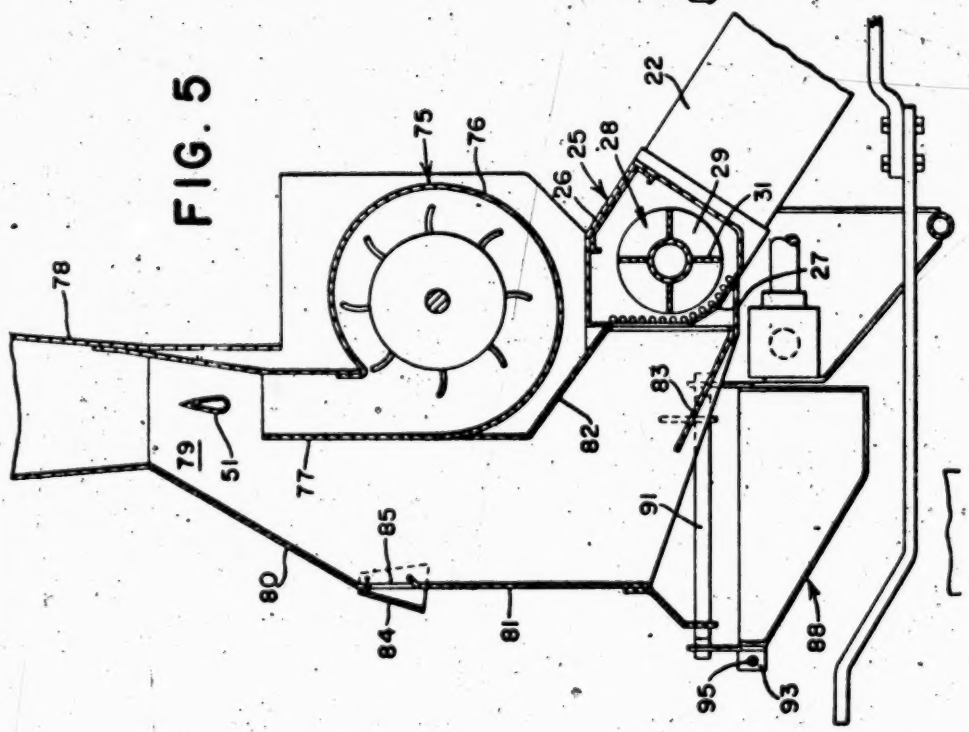


ILLUSTRATION III

Fig. 2.

FIG. 3

ILLUSTRATION IV

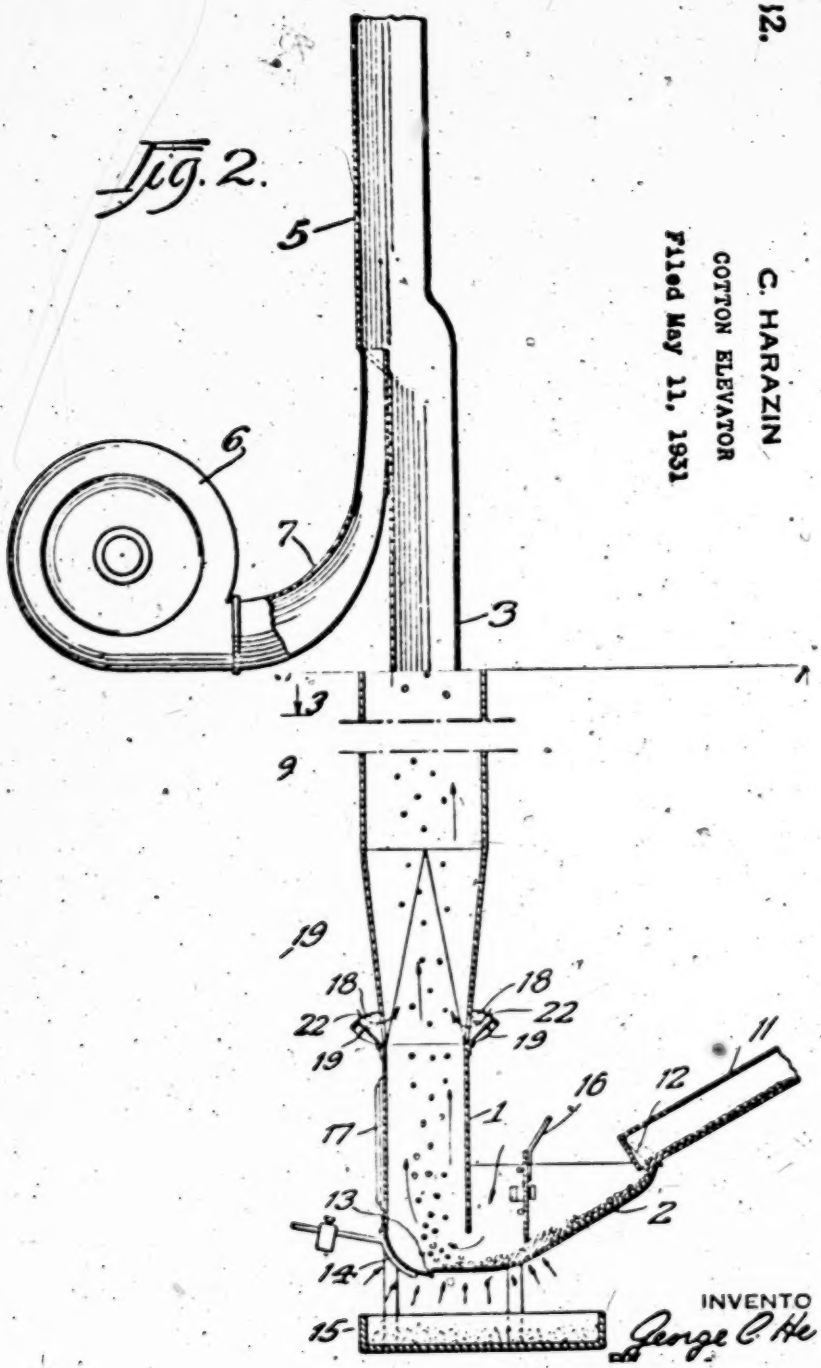
12.

C. HARAZIN

COTTON ELEVATOR

Filed May 11, 1931

Fig. 2.



INVENTO

George C. He